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10/744,009

12/24/2003

Anthony Paul Mayo

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EXAMINER

HAMILTON, MATTHEW L

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/744,009	<b>Applicant(s)</b> MAYO, ANTHONY PAUL	
	<b>Examiner</b> MATTHEW L. HAMILTON	<b>Art Unit</b> 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/24/2003</u> .                                              | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### Status of Claims

1. This action is in reply to the initial filing filed on 24 December 2003.
2. Claims 21-50 are currently pending and have been examined.
3. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

### Information Disclosure Statement

4. The Information Disclosure Statement filed on 24 December 2003 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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6. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 21-23, 26-28, 30-33, 35-38, 40-43, 45-48 and 50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 7-8 and 13-14 of U.S. Patent No. 6,678,663 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are similar in language and scope.

<u>Instant Claim</u>	<u>Claims in US Patent 6,678,663 B1</u>
21	1
22	1
23	2
26	7
27	7
28	8
30	7
31	13
32	13
33	14
35	13
36	1
37	1
38	2
40	1
41	7
42	7
43	8
45	7
46	13
47	13
48	14
50	13

9. Claims 21-22 and 36-37 and 40 differs from claim 1 in the '663 patent by rewording the claims and moving elements from the independent claim to the dependent claims. Similarly, the same concept can be applied to claims 26-27, 30, 41-42 and 45 correspond to claim 7 related to patent '663. Also, claims 31-32, 35, 46-47 and 50 correspond to claim 13 related to patent '663.

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10. Claims 23 and 38 are similar to dependent claim 2 from patent '663. Similarly, the same idea applies to claims 28 and 43 correspond to claim 8 from patent '663. Also, claims 33 and 48 relate to claim 14 from patent '663.

### ***EXAMINER'S NOTE***

11. It appears the Applicant is attempting to invoke 35 U.S.C. 112, 6<sup>th</sup> paragraph in Claims 15, 16, and claims 31 and 46 by using "means-plus-function" language, such as "means for receiving", "means for generating", "means for storing", etc. in the above claims. In order to successfully invoke the sixth paragraph, a three-prong test must be met. Namely, (1) the claim must use means-plus-function language; (2) the claim itself must not provided structural limitations to the means-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function language in the claim. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong. There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function limitations in the claims. Therefore, 35 U.S.C 112, 6<sup>th</sup> paragraph has not been successfully invoked. The Examiner will consider the means to perform the claimed functions as any means, physical or virtual, that can perform the function.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 21-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mini et al. US Patent 6,684,196 B1; Shibata US Patent 6,295,552 B1 and Herz et al. US Patent 5,754,938.

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**Claims 21, 26, 31, 36, 41 and 46:**

As per claims 21, 26, 31, 36, 41 and 46, **Mini** teaches the method, computer readable medium and system comprising the steps of:

*receiving at a server first user information from a first user, where the first user information comprises the identity of the user* (column 6, line 59 to column 7, line 13).

*receiving at the server a plurality of transaction descriptions* (column 6, lines 59-64 and column 7, lines 4-18).

*receiving at the server a request from a second user for at least one of the plurality of transaction descriptions* (column 2, lines 51-54 and column 5, lines 25-29).

*displaying at least one of the transaction description pages from the server to the second user, where the at least one displayed transaction description page corresponds to the requested transaction description* (column 7, lines 42-45).

*receiving a request at the server from the first user to view at least one of the plurality of transaction descriptions* (column 6, line 59 to column 7, line 13).

**Mini** does not teach *generating at the server a unique email address for each of the plurality of transaction descriptions, where email transmissions sent to the unique email address are accessible by the first user*. However, **Shibata** teaches a gateway apparatus for transferring voice mail to an electronic mail server or transferring electronic mail to a voice mail apparatus in column 1, lines 10-18 and further teaches, "An address conversion unit 16 converts an electronic mail address into a voicemail box number, and converts a voice mail box number into an electronic mail address in accordance with an address conversion table corresponding between a voice mail box number assigned to a user and an electronic mail address assigned to said user." (Shibata, 5, column 5, lines 44-51) and "Then, the

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*electronic mail file corresponding to the retrieved voicemail is transferred to the electronic mail server 5 so that the electronic mail file is distributed to one of the personal computers 3 assigned for the user to whom the voicemail is addressed. The routine then returns to step 35 to repeat the voice mail retrieving operation."* (column 6, lines 27-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Mini to allow unique email address to be accessible by first user. One would have been motivated to allow unique email address to be accessible by first user in order to highlight and display information to user.

**Mini** and **Shibata** do not explicitly teach *storing at a storage device the received plurality of transaction descriptions, the transaction description page generated for each transaction description, and the unique email address for each transaction description*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Mini to store transaction descriptions, transaction description page for each transaction description and the unique e-mail address for each transaction. For example, credit card companies store transaction description of purchases made by customers and unique e-mail addresses for offers sent to customers in order to maintain a file of customer history.

**Mini** and **Shibata** do not teach *generating at the server a transaction description page for each of the transaction description, where the transaction description page includes a message soft button that enables an email message to be sent to the unique email address associated with the transaction description and does not provide the identity of the first user nor receiving an email transmission at the server, where the email transmission is from the second user activating the message soft button and the email transmission is directed toward the unique email address and does not provide the identity of the second user*. However, **Hertz** teaches pseudonymous server for system for customized electronic identification of desirable objects in column 1, lines 17-41 and further teaches, *"The disclosed system provides a solution to the privacy problem by using a proxy server which acts as an intermediary between information provider and the user. The proxy server dissociates the user's true identity from the pseudonym by the user of cryptographic techniques."* (column 5, lines 50-55) and *"Examples of target*

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*objects can include but not limited to: a newspaper story of potential interest, a movie to watch, an item to buy, e-mail to receive or another person to correspond with."* (column 6, lines 8-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Mini to communicate via e-mail without providing the identity of the user. One would have been motivated to communicate via e-mail without providing the identity of the user in order provide anonymity between parties.

*generating at the server a display page comprising at least one transaction description hyper-text links and at least one message hyper-text links, where:*

*a) the at least one transaction description hypertext link corresponds to one transaction description page for a transaction description* (column 6, line 59 to column 7, line 13).

**Mini, Shibata and Hertz** do not teach *and b) the at least one message hyper-text link corresponds to one unique email address*. However, it would have been obvious to one of ordinary skill in the art at the invention of Mini to add a hyper-text link corresponding to one unique e-mail address. For example, hyper-text links have been added to e-mails for instance, a customer receives an e-mail regarding a coupon a hyper text link is added to the e-mail in order to direct the consumer to store website or coupon.

*and transmitting from the server the display page to the first user* (column 6, line 59 to column 7, line 13).

**Mini, Shibata and Hertz** do not teach *receiving at the server a request to access at least one email transmission*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Mini to receive server request to access one email transmission. For example, when sending targeted advertisements via electronic mail, the advertiser or marketer requests view and access e-mail transmission in order to make sure advertisements were sent to the intended user.

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*transmitting an email page from the server to the first user, where the email page comprises:*

**Mini, Shibata** and **Hertz** do not teach *a) the text of the email transmission*. However, **Official Notice** is taken that it is old and well known in the computer arts to add text to the electronic mail sent to the user. For example, advertisers and marketers send information via electronic mail with text to notify users of potential sales or discounts.

**Mini** and **Hertz** do not teach *b) a message soft button that enables an email message to be sent to the second user at the unique email address associated with the transaction description*. However, **Shibata** teaches a gateway apparatus for transferring voice mail to an electronic mail server or transferring electronic mail to a voice mail apparatus in column 1, lines 10-18 and further teaches, "An address conversion unit 16 converts an electronic mail address into a voicemail box number, and converts a voice mail box number into an electronic mail address in accordance with an address conversion table corresponding between a voice mail box number assigned to a user and an electronic mail address assigned to said user." (Shibata, 5, column 5, lines 44-51) and "Then, the electronic mail file corresponding to the retrieved voicemail is transferred to the electronic mail server 5 so that the electronic mail file is distributed to one of the personal computers 3 assigned for the user to whom the voicemail is addressed. The routine then returns to step 35 to repeat the voice mail retrieving operation." (column 6, lines 27-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention of Mini to enable e-mail message to be sent to second user at the unique address associated with the transaction description. One would have been motivated to enable e-mail message to be sent to second user at the unique address associated with the transaction description in order to categorize and identify each of the advertised listings send via e-mail.

**Mini, Shibata** and **Hertz** do not teach *and receiving a second email transmission at the server*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention of Mini to receive second email transmission at the server. One would have been motivated to receive second email

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transmission at the server in order to store e-mail transmission in the network. For example, the server is known to perform many activities such as receive and send data.

**Claims 22, 27, 32, 37, 42 and 47:**

As per claims 22, 27, 32, 37, 42 and 47 **Mini, Shibata** and **Hertz** teach the method of claim 21, computer readable medium of claim 26, system of claim 31, method of claim 36, computer readable medium of claim 41 and system of claim 46 as described above and **Mini** further teaches *wherein the at least one of the plurality of transaction descriptions is an offer for sale of at least one of a good and a service* (column 6, line 59 to column 7, line 13).

**Claims 23, 28, 33, 38, 43 and 48:**

As per claims 23, 28, 33, 38, 43 and 48 **Mini, Shibata** and **Hertz** teach the method of claim 22, the computer readable medium of claim 27, system of claim 32, method of claim 37, computer readable medium of claim 42 and system of claim 47 as described above and **Mini** further teaches *where the at least one of a good and a service comprises a real estate listing* (column 6, line 59 to column 7, line 13).

**Claims 24, 29, 34, 39, 44 and 49:**

As per claims 24, 29, 34, 39, 44 and 49 **Mini, Shibata** and **Hertz** teach the method of claim 22, the computer readable medium of claim 27, the system of claim 32, method of claim 37, computer readable medium of claim 42 and system of claim 47 as described above and **Mini** further teaches *where the at least one of a good and a service comprises a retail product* (column 6, line 59 to column 7, line 13).

**Claims 25, 35, 40, 45 and 50:**

As per claims 25, 35, 40, 45 and 50 **Mini, Shibata** and **Hertz** teach the method of claim 21, system of claim 31, method of claim 36, computer readable medium of claim 41 and the system of claim

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46 as described above and **Mini** further teaches where:

*a) at least one of the plurality of transaction descriptions is received from a first user (column 6, line 59 to column 7, line 13).*

*b) each of the plurality of transaction descriptions is an offer for sale of at least one of a good and a service (column 6, line 59 to column 7, line 13).*

*c) each of the plurality of transaction descriptions comprise identification indicia, price indicia and location indicia (column 6, line 59 to column 7, line 13).*

*d) each of the plurality of transaction descriptions is associated with the first user and the first user information (column 6, line 59 to column 7, line 13).*

### **Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW L. HAMILTON whose telephone number is (571)270-1837. The examiner can normally be reached on Monday-Friday 7:30a.m-5p.m EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative

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or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLH  
Examiner, Art Unit 3688  
September 10, 2008

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688